

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ERNESTINA CASTRO, S.A. DE. C.V.

Petitioner

v.

DOCEIRA CAMPOS DO JORDAO LTDA.

Registrant

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Cancellation No. 92043753



05-13-2005

U.S. Patent & TMOfo/TM Mail Rcpt Dt. #74

**PETITIONER'S MOTION TO STRIKE LATE ANSWER AND FOR DEFAULT
JUDGMENT**

Petitioner Ernestina Castro, S.A. de C.V. ("Petitioner"), by its undersigned counsel, hereby respectfully moves for entry of an Order striking the answer to the amended petition for cancellation filed by Registrant Doceira Campos Do Jordao Ltda ("Registrant"), and for default judgment.

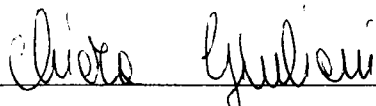
On January 25, 2005, Petitioner filed and served a motion for leave to amend the petition for cancellation, and an amended petition for cancellation. Copy of the motion and amended petition are attached as Exhibit A. Petitioner's motion was granted by the Board on March 8, 2005. A copy of the Board's order is attached as Exhibit B. The Board ordered that Registrant file its answer to the amended petition for cancellation within thirty days from March 8, 2005, the mailing date of the order. Thus, Registrant's answer to the amended petition for cancellation was due on or before April 7, 2005. However, no answer was filed by the deadline. The time for filing an answer may be extended by stipulation of the parties approved by the Board, or by motion granted by the Board. TBMP §310.03(c). Registrant never requested Petitioner's

consent to an extension of the time for filing the answer, nor did Registrant file a motion with the Board requesting such an extension. Rather, Registrant filed and served its answer on April 11, 2005, after the deadline set by the Board in its order dated March 8, 2005, and thus its answer is not timely. A copy of Registrant's amended answer is attached as Exhibit C.

In a cancellation proceeding, if an answer is not filed within the time set, the petition may be decided as in case of default. 37 CFR §2.114(a). Because Registrant's failed to file a timely answer to Petitioner's amended petition for cancellation, Petitioner hereby moves for entry of default judgment against Registrant. 37 CFR §2.114(a). TBMP §§312 and 508.

Respectfully submitted,

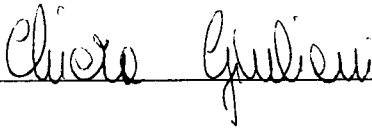
ERNESTINA CASTRO, S.A. DE. C.V.

By: 
Cristina A. Carvalho
Chiara Giuliani
Arent Fox PLLC
1050 Connecticut Avenue, N.W.
Washington, D.C. 20036-5339
(202) 857-6000

Attorneys for Petitioner

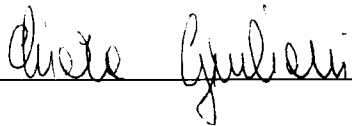
CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing Motion is being served upon Registrant's counsel Robert B. Golden, Lackenbach Siegel LLP, One Chase Road, Scarsdale, New York 10583 this 11th day of May 2005 marked first class mail, postage prepaid.



CERTIFICATE OF MAILING

It is hereby certified that the attached Motion (re Canc. No. 92043753) is being deposited with the U.S. Postal Service address to the Hon. Commissioner for Trademarks, P.O. BOX 1451, Alexandria, Virginia 22313 this 11th day of May 2005 marked first class mail, postage prepaid.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ERNESTINA CASTRO, S.A. DE. C.V.

Petitioner

v.

DOCEIRA CAMPOS DO JORDAO LTDA.

Registrant

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Cancellation No. 92043753

PETITIONER'S MOTION FOR LEAVE TO AMEND

Pursuant to Rule 15(a) of the Federal Rules of Civil Procedure, Petitioner Ernestina Castro, S.A. De C.V hereby moves for leave to amend its petition for cancellation in the above referenced proceeding. An amended petition for cancellation is submitted herewith.

The Board's leave is requested so that Petitioner may plead its registration for the mark PAN SANTA EDUVIGIS, which is material to this proceeding.

Permission for leave to amend a pleading "shall be freely given when justice so requires". F.R.C.P. 15(a). In this case the interests of justice will be served by allowing Petitioner to amend its petition for cancellation to allege additional grounds.

Permitting an amendment at this stage in the proceeding will not prejudice Registrant in any manner. After the petition for cancellation was filed, Registrant timely filed the answer. However, the parties have not started taking discovery. Since the amended petition contains matter which the Board should consider in order to make a fair evaluation of this proceeding, the policy underlying Rule 15(a) will be advanced by the granting of this motion for leave to amend.

Petitioner further moves that this proceeding be suspended pending the Board's decision on the motion for leave to amend.

ERNESTINA CASTRO, S.A. DE. C.V.

By Chiara Giuliani
Cristina A. Carvalho
Chiara Giuliani
Arent Fox PLLC
1050 Connecticut Avenue, NW
Washington, DC 20036
(202) 857-6000

Attorney for Petitioner

CERTIFICATE OF SERVICE

It is hereby certified that copies of the foregoing Motion for leave to amend and the amended petition to cancel are being served upon Registrant's counsel Robert B. Golden, Lackenbach Siegel LLP, One Chase Road, Scarsdale, New York 10583 this 25th day of January 2005 marked first class mail, postage prepaid.

Chiara Giuliani

CERTIFICATE OF MAILING

It is hereby certified that the attached Petitioner's Motion for Leave to Amend and Amended Petition to Cancel (re Canc. No. 92043753) are being deposited with the U.S. Postal Service address to the Hon. Commissioner of Trademarks, P.O. BOX 1451, Alexandria, Virginia 22313 this 25th day of January 2005 marked first class mail, postage prepaid.

Chiara Giuliani

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Registration No. 2,781,559 for the mark SANTA EDWIGES & Design issued on
November 11, 2003

ERNESTINA CASTRO, S.A. DE C.V.	:	
A Salvadorian Corporation	:	
	:	
Petitioner	:	
	:	
v.	:	Canc. No.92043753
	:	
DOCEIRA CAMPOS DO JORDAO LTDA.	:	
A Brazilian Corporation	:	
	:	
Registrant	:	

AMENDED PETITION FOR CANCELLATION

Petitioner Ernestina Castro, S.A. de C.V ("Petitioner") believes that it will be damaged by the continued existence of Registration No. 2,781,559 and hereby petitions to cancel this registration pursuant to Section 14 of the Trademark Act of 1946, 15 U.S.C. §1064. As grounds for cancellation, Petitioner alleges that:

1. Petitioner is the owner of all right, title and interest in and to the mark PAN SANTA EDUVIGIS for a variety of food products including cookies, pies, cakes, pancakes, pancake mixes and flour in Class 30.
2. The Patent and Trademark Office has recognized Opposer's exclusive right to use the mark PAN SANTA EDUVIGIS by issuing Reg. No. 2,585,075, on June 25, 2002.
3. Petitioner's registration for the mark PAN SANTA EDUVIGIS is valid and subsisting, and provides *prima facie* evidence of Petitioner's ownership of the mark PAN SANTA EDUVIGIS, and of its exclusive right to use this mark in commerce.

4. Since long prior to the acts complained of in this notice, Petitioner has continuously used the mark PAN SANTA EDUVIGIS in connection with its food products in several countries, including the United States.

5. Since the initial use of the mark, Petitioner has made a substantial investment in advertising and promoting its goods under the mark PAN SANTA EDUVIGIS.

6. As a result of the significant advertising and publicity, and of several years of continuous use in the marketplace, Petitioner's mark has become known as a distinctive indicator of the origin of Petitioner's goods, and it symbolizes Petitioner's valuable goodwill.

7. Notwithstanding Petitioner's prior rights in its mark, Registrant has obtained Registration No. 2,781,559, for the mark SANTA EDWIGES & Design for "farinaceous food paste, namely, alimentary pastes; cookies; biscuits; petit beurre biscuits; crackers; risks; cake paste and cake powder, namely, cake mixes; cakes; sweetmeats; caramels; chewing gum; chocolate; edible ices; candy; ferments for pastes, namely, yeast; corn flakes; pies; fondants, fruit jellies in the nature of confectionery; bread rolls; pancakes; bread; popped popcorn; petit fours, puddings; ice cream; waffles; and panettones, in Class 30".

8. Upon information and belief, Registrant made no use of its alleged mark in commerce prior to the filing date of its application.

9. Upon information and belief, when Registrant applied to register the mark at issue, Registrant had full knowledge of Petitioner's prior rights in the mark PAN SANTA EDUVIGIS.

10. Petitioner has used its mark PAN SANTA EDUVIGIS continuously on or in connection with its goods in interstate commerce since long prior to the filing date of Registrant's application which matured into Reg. No. 2,781,559.

11. Registrant's alleged mark so resembles Petitioner's mark that the use thereof by Registrant, and the continued existence of Registration No. 2,781,559, is likely to cause confusion, mistake and/or deception within the meaning of Section 2(d) of the Trademark Act as to the source or origin of Registrant's goods, and will injure and damage Petitioner and the goodwill and reputation symbolized by Petitioner's mark.

12. Petitioner has been and will be damaged by the continued existence of Registration No. 2,781,559 because the mark shown in the registration is likely to cause confusion, mistake or deception among consumers who may believe that the goods of Registrant emanate from or are in some way sponsored or endorsed by or associated with Petitioner.

13. Registrant is not affiliated or connected with or endorsed or sponsored by Petitioner, nor has Petitioner approved any goods or services offered or sold by Registrant under the mark SANTA EDWIGES & Design, nor has Petitioner granted Registrant permission to use said mark

14. Petitioner's goods and those of Registrant are identical or so closely related that the public is likely to be confused and to assume erroneously that Registrant's goods are Petitioner's goods or that Registrant is connected with, sponsored by or affiliated with Petitioner.

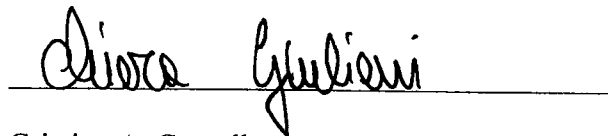
15. Upon information and belief, Registrant adopted the registered mark and has subsequently used the registered mark with a deliberate intent to cause confusion among purchasers as to the source of its products.

16. Likelihood of confusion in this case is enhanced by the fact that the word EDWIGES in Registrant's mark SANTA EDWIGES & Design is a translation into English of the word EDUVIGIS in Petitioner's mark PAN SANTA EDUVIGIS.

WHEREFORE, Petitioner requests that the Board grant this petition for cancellation.

ERNESTINA CASTRO S.A.DE C.V.

By

A handwritten signature in dark ink, appearing to read "Chiara Giuliani", is written over a horizontal line.

Cristina A. Carvalho
Chiara Giuliani
Arent Fox PLLC
1050 Connecticut Avenue, NW
Washington, D.C. 20036
(202) 857-6000

Attorneys for Petitioner

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

Taylor

Mailed: March 8, 2005

Cancellation No. 92043753

Ernestina Castro, S.A. de C.V.

v.

Doceira Campos Do Jordao Ltda.

Jyll S. Taylor, Attorney:

On January 31, 2005, petitioner filed a combined motion to amend its petition for cancellation to claim ownership of a registration and for suspension of this proceeding pending the Board's decision on the motion to amend.¹

The record shows no response by respondent to the motion to amend.

Accordingly, petitioner's motion to amend the petition for cancellation is granted as conceded and petitioner's concurrently filed amended petition for cancellation is now petitioner's operative pleading in this case. See Fed. R. Civ. P. 15 and Trademark Rule 2.127(a). Respondent is allowed until **thirty days** from the mailing date of this

¹ The Board notes petitioner's withdrawal of its motion to suspend filed January 31, 2005. Accordingly, no further consideration will be given to the motion to suspend.

Cancellation No. 92043753

order to file an answer to the amended petition for
cancellation.

Discovery and trial dates remain as set in the Board's
October 7, 2004 institution order.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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ERNESTINA CASTRO, S.A. de C.V., :
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Petitioner, :
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v. :
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DOCEIRA CAMPOS DO JORDÃO :
LTDA., :
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Registrant. :
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Certificate of Mailing

I hereby certify that this correspondence
is being deposited with the United States Postal
Service as first class mail in an envelope
addressed to the Commissioner for Trademarks,
R.O. Box 1451, Alexandria, VA 22313-1451

[Signature]

Cancellation No. 92043753
Registration No. 2781559

ANSWER TO AMENDED PETITION FOR CANCELLATION

Doceira Campos Do Jordão Ltda. ("Registrant"), for its answer and defenses to the
Petition for Cancellation filed by Ernestina Castro, S.A. de C.V. ("Petitioner"), states as follows:

1. Registrant is without information or knowledge sufficient to form a belief as to the truth
of the allegations of Paragraphs 1, 3, 4, 5, 6, 10, and 13 of the Petition for Cancellation,
and therefore denies same.
2. Registrant denies the allegations of Paragraphs 2, 9, 11, 12, 14, 15, and 16 of the Petition
for Cancellation.
3. Registrant is without information or knowledge sufficient to form a belief as to the truth
of Petitioner's assertion of "prior rights," in Paragraph 7 of the Petition for Cancellation,
and therefore denies such allegation, but otherwise admits the remaining allegations of
Paragraph 5.
4. Registrant admits, with respect to Paragraph 8 of the Petition for Cancellation, that
Registrant initially filed U.S. Trademark Application Serial No. 76457276 as an "intent-
to-use" application under section 1(b), and subsequently converted the application to be



04-22-2005

based upon a foreign registration under section 44(e), but Registrant otherwise denies the allegations of Paragraph 6.

AFFIRMATIVE DEFENSES

1. Petitioner's claims are barred by the doctrines of laches, acquiescence, estoppel, and/or waiver.
2. Registrant's mark SANTA EDWIGES & Design is not confusingly similar to Petitioner's mark PAN SANTA EDUVIGIS.
3. There is no likelihood of confusion.

Dated: Scarsdale, New York
April 11, 2005

LACKENBACH SIEGEL LLP

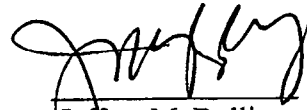
By: 

Robert B. Golden
Jeffrey M. Rollings
Attorneys for Registrant
One Chase Road
Scarsdale, New York 10583
(914) 723-4300

CERTIFICATE OF SERVICE

I hereby certify that a true and accurate copy of the enclosed ANSWER TO AMENDED PETITION FOR CANCELLATION was served on counsel for Petitioner on April 11, 2005, by First Class Mail, addressed to counsel for Petitioner as follows:

Chiara Guiliani, Esq.
Arent Fox PLLC
1050 Connecticut Avenue, NW
Washington, D.C. 20036



Jeffrey M. Rollings